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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,708	01/27/2004	Deborah A. Klinkert	20067.0021US01	2573
52835 7590 05/29/2007 HAMRE, SCHUMANN, MUELLER & LARSON, P.C. P.O. BOX 2902 MINNEAPOLIS, MN 55402-0902			EXAMINER EDWARDS, LOREN C	
			ART UNIT 3748	PAPER NUMBER
			MAIL DATE 05/29/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

8

Office Action Summary	Application No. 10/765,708	Applicant(s) KLINKERT ET AL.	
	Examiner Loren C. Edwards	Art Unit 3748	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6-8,10-15 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6-8,10-15 and 17-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to. .
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/7/07 has been entered.
2. An Applicant's Amendment filed on 5/7/07 has been entered. Claims 2, 5, 9, and 16 have been canceled; claims 1, 3, 4, 6-8, and 10-15 have been amended; and claims 17-20 have been added. Overall, claims 1, 3, 4, 6-8, 10-15, and 17-20 are pending in the application.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

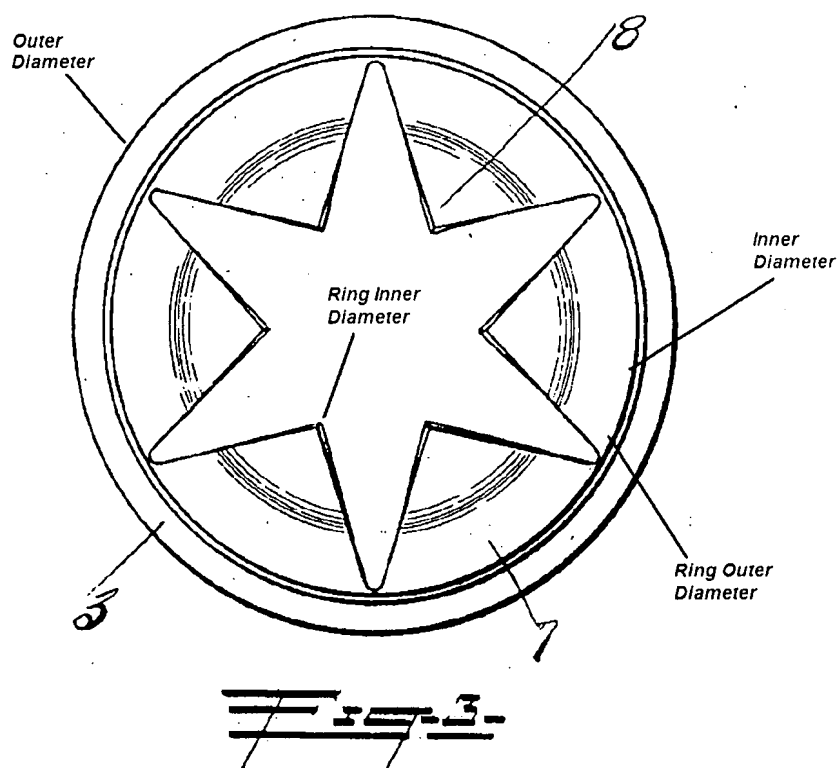
A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 3, 4, 6, 11, 13, and 17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Pribil (U.S. 1,530,324). Pribil discloses an exhaust assembly for a marine genset, the exhaust assembly comprising: a combustion engine (Fig. 1, No. 1) having an exhaust (Fig. 1, No. 2) to emit cooling water and exhaust gases (inherent to hydrocarbon burning internal combustion engine exhaust); a sound-dampening device

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(Fig. 1, No. 3) coupled between the exhaust (Fig. 1, No. 2) and a muffler (Fig. 1, No. 11), the sound-dampening device including a tubular member (Fig. 1, No. 3) having an inner diameter (Modified Fig. 3, Inner Diameter) and two or more rings (Fig. 2, No. 7) located on the inner diameter of the tubular member; each ring having an inner surface (Figs. 3 and 4) exposing directly to an exhaust gas passageway in the tubular member, the rings being configured to provide constriction of the passageway which causes mixing of the cooling water with the exhaust gas to reduce noise generated by the combustion engine (Col. 1, Lines 9-19).



Modified Fig. 3 – Added reference notations

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5. With regards to claim 3, Pribil discloses the exhaust assembly of claim 1, as described above, and further wherein the tubular member includes a flexible exhaust hose (Fig. 1, No. 3) for connecting between the exhaust and the muffler, the flexible exhaust hose having an inner diameter (Modified Fig. 3, Inner Diameter), and the two or more rings are located on the inner diameter of the flexible exhaust hose (Fig. 3, Nos. 3 and 7), each ring having an outer diameter (Modified Fig. 3, Ring Outer Diameter) the same as the inner diameter of the flexible exhaust hose and an inner diameter (Modified Fig. 3, Ring Inner Diameter) smaller than the inner diameter of the flexible exhaust hose.

6. With regards to claim 4, Pribil discloses the exhaust assembly of claim 1, as described above, and further wherein the tubular member includes an exhaust tube having (Fig. 1, No. 3) a first end (Fig. 3, No. 10) connectable to the exhaust, the tube including an inner diameter (Modified Fig. 3, Inner Diameter), the inner diameter having the at least two rings mounted thereto (Fig. 2, No. 8), each ring having an outer diameter (Modified Fig. 3, Ring Outer Diameter) the same as the inner diameter of the tube and an inner diameter (Modified Fig. 3, Ring Inner Diameter) smaller than the inner diameter of the tube.

7. With regards to claim 6, Pribil discloses an exhaust apparatus for a marine genset comprising: a flexible exhaust hose (Fig. 1, No. 3) for connecting between a combustion engine (Fig. 1, No. 1) and a muffler (Fig. 1, No. 11), the flexible exhaust hose having an inner diameter (Modified Fig. 3, Inner Diameter); and two or more rings (Fig. 2, No. 7) located on the inner diameter of the flexible exhaust hose, each having

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an outer diameter (Modified Fig. 3, Ring Outer Diameter) the same as the inner diameter of the flexible exhaust hose and an inner surface having an inner diameter (Modified Fig. 3, Ring Inner Diameter) smaller than the inner diameter of the flexible exhaust hose, each of the inner surfaces of the rings exposing directly to an exhaust gas passageway in the exhaust hose (Figures 1 and 2), the rings being configured to provide constriction of the passageway which causes mixing of the cooling water with the exhaust gas to reduce noise generated by the combustion engine (Col. 1, Lines 9-19).

8. With regards to claim 11, Pribil discloses an exhaust apparatus for a marine genset, comprising: a rigid tube (Fig. 1, No. 10) having a first end (Fig. 1, No. 10 – upstream end) connectable to an exhaust outlet of a combustion engine (Fig. 1, Nos. 1 and 2), the tube including an inner diameter (Modified Fig. 3, Inner Diameter), the inner diameter having at least two rings (Fig. 2, No. 7) mounted thereto, each ring having an outer diameter (Modified Fig. 3, Ring Outer Diameter) the same as the inner diameter of the tube and an inner diameter (Modified Fig. 3, Ring Inner Diameter) smaller than the inner diameter of the tube, each ring having an inner surface exposing directly to an exhaust gas passageway in the tube (Figures 1 and 2), the rings being configured to provide constriction of the passageway which causes mixing of the cooling water with the exhaust gas to reduce noise generated by the combustion engine (Col. 1, Lines 9-19).

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9. With regards to claim 13, Pribil discloses the exhaust apparatus of claim 11, as described above, and further wherein the second end (Fig. 1, No. 10 – downstream end) of the tube is connectable to a flexible marine exhaust hose (Fig. 1, No. 3).

10. With regards to claim 17, Pribil discloses an exhaust system for a marine genset, the exhaust assembly comprising: a combustion engine having an exhaust to emit cooling water and exhaust gases (Fig. 1, Nos. 1 and 2); a muffler (Fig. 1, NO. 3); a water separator (Fig. 1, No. 3); an exhaust hose (Fig. 1, No. 10) connecting the exhaust and the muffler; and an exhaust tube (Fig. 1, No. 3) between the exhaust and the exhaust hose, the tube having an inner diameter (Modified Fig. 3, Inner Diameter) and two or more rings (Fig. 2, No. 7) located on the inner diameter, each ring having an outer diameter (Modified Fig. 3, Ring Outer Diameter) the same as the inner diameter of the tube and an inner diameter (Modified Fig. 3, Inner Diameter) smaller than the inner diameter of the tube, each ring having an inner surface exposing directly to an exhaust gas passageway in the tube (Figures 1 and 2), the rings being configured to provide constriction of the passageway which causes mixing of the cooling water with the exhaust gas to reduce noise generated by the combustion engine (Col. 1, Lines 9-19).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claims 7, 14, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pribil in view of design choice. Pribil discloses the apparatus of claims 3, 4, 6, 11, and 17, as described above, but does not expressly disclose wherein the two or more rings are evenly spaced about 4 ½ inches apart from each other along a length of the flexible hose. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to make the rings spaced about 4 ½ inches apart because Applicant has not disclosed that the spacing provides an advantage, is used for a particular purpose, or solves a stated problem. Furthermore, the scale of the exhaust tube of Pribil would ultimately determine the spacing of the rings and, depending on the distance that needed to be covered, a spacing of 4 ½ inches would be well within the reasonable spacing as shown by Figures 1 and 2 of Pribil. Therefore, it would have been an obvious matter of design choice to modify Pribil to obtain the invention as specified in claims 7, 14, and 18-20.

14. Claims 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pribil in view of design choice. Pribil discloses the apparatus of claim 6, as described above, but does not expressly disclose wherein the exhaust tube has an outside

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diameter of about 2 inches or wherein the length is 6 feet or less. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to make the exhaust tube 2 inches in diameter or 6 feet in length because Applicant has not disclosed that the diameter or length provide an advantage, are used for a particular purpose, or solve a stated problem. Furthermore, the length and diameter of exhaust tubing are common considerations in the design of automotive exhausts and the claimed dimensions are very typical in the art. Therefore, it would have been an obvious matter of design choice to modify Pribil to obtain the invention as specified in claims 8 and 10.

15. Claims 12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pribil in view of design choice. Pribil discloses the apparatus of claim 11, as described above, but fails to expressly disclose the tube and the rings being made of stainless steel. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to make the tube and rings out of stainless steel because Applicant has not disclosed that the stainless steel material provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well being made of stainless steel because stainless steel is commonly used in internal combustion engine exhaust applications. Therefore, it would have been an obvious matter of design choice to modify Bishop to obtain the invention as specified in claim 15.

Response to Arguments

16. Applicant's arguments with respect to the rejected claims have been considered but are moot in view of the new ground(s) of rejection.

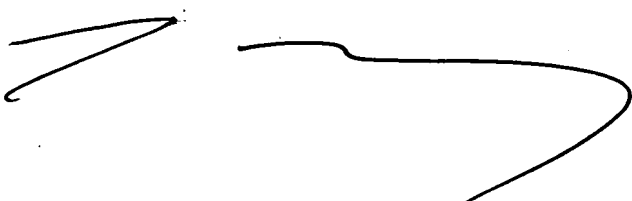
Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Loren C. Edwards whose telephone number is (571) 272-2756. The examiner can normally be reached on M-TH 5:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Denion can be reached on (571) 272-4859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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